



3510-16-P

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Madrid Protocol

ACTION: Proposed collection; comment request.

SUMMARY: The United States Patent and Trademark Office (USPTO), as required by the Paperwork Reduction Act of 1995, invites comments on a proposed extension of an existing information collection: 0651-0051 (Madrid Protocol).

DATES: Written comments must be submitted on or before [INSERT DATE 60 DAYS AFTER THE DATE OF PUBLICATION IN THE FEDERAL REGISTER].

ADDRESSES: You may submit comments by any of the following methods:

- *Email:* InformationCollection@uspto.gov. Include “0651-0051 comment” in the subject line of the message.
- *Federal Rulemaking Portal:* <http://www.regulations.gov>.
- *Mail:* Catherine Cain, Attorney Advisory, Office of the Commissioner for Trademarks, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

FOR FURTHER INFORMATION CONTACT: Requests for additional information should be directed to Catherine Cain, Attorney Advisor, Office of the Commissioner for Trademarks, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450; by telephone at 571-272-8946; or by email at Catherine.Cain@uspto.gov with “0651-0051 comment” in the subject line. Additional

information about this collection is also available at <http://www.reginfo.gov> under “Information Collection Review.”

SUPPLEMENTARY INFORMATION

I. Abstract

This collection of information is required by the Trademark Act of 1946, 15 U.S.C. § 1051 *et seq.*, which provides for the Federal registration of trademarks, service marks, collective trademarks and service marks, collective membership marks, and certification marks. Individuals and businesses that use or intend to use such marks in commerce may file an application to register the marks with the United States Patent and Trademark Office (USPTO).

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (“Madrid Protocol”) is an international treaty that allows a trademark owner to seek registration in any of the participating countries by filing a single international application. The International Bureau (IB) of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland, administers the international registration system. The Madrid Protocol Implementation Act of 2002 amended the Trademark Act to provide that: (1) the owner of a U.S. application or registration may seek protection of its mark in any of the participating countries by submitting a single international application to the IB through the USPTO, and (2) the holder of an international registration may request an extension of protection of the international registration to the United States. The Madrid Protocol became effective in the United States on November 2, 2003, and is implemented under 15 U.S.C. § 1141 *et seq.*, and 37 CFR Part 2 and Part 7.

An international application submitted through the USPTO must be based on an active U.S. application or registration and must be filed by the owner of the application or registration. The USPTO reviews the international application to certify that it corresponds to the data contained in the existing U.S. application or registration before forwarding the international application to the IB. The IB then reviews the international application to determine whether the Madrid filing requirements have been met and the required fees have been paid. If the international application is unacceptable, the IB will send a notice of irregularity to the USPTO and the applicant. The applicant must respond to the irregularities to avoid abandonment, unless a response from the USPTO is required. After any irregularities are corrected and the application is accepted, the IB issues an international registration number, publishes the registration in the WIPO Gazette of International Marks, and sends the certificate to the holder.

When the international registration is issued, the IB notifies each country designated in the application of the request for extension of protection. Each designated country then examines the request under its own laws. Once an international registration exists, the holder may also file subsequent designations to request an extension of protection to additional countries or request extension of goods/services not already extended to previously designated countries.

Under Section 71 of the Trademark Act, 15 U.S.C. § 1141(k), a registered extension of protection to the United States will be cancelled unless the holder of the international registration periodically files affidavits of continued use in commerce or excusable nonuse. The first affidavit must be filed on or between the fifth- or sixth-year anniversaries of the date on which the USPTO registers an extension of protection.

This collection includes the information necessary for the USPTO to process applications for international registration and related requests under the Madrid Protocol. The USPTO provides electronic forms for filing the items in this information collection online (except for the Request to Record an Assignment or Restriction of a Holder's Right to Dispose of an International Registration) using the Trademark Electronic Application System (TEAS), which is available through the USPTO Web site.

Applicants may also submit the items in this collection on paper or by using the forms provided by the IB, which are available on the WIPO Web site. The IB requires Applications for International Registration and Applications for Subsequent Designation that are filed on paper to be submitted on the official IB forms.

II. Methods of Collection

Electronically, if applicants submit the information using the TEAS forms. By mail or hand delivery, if applicants choose to submit the information in paper form.

III. Data

OMB Number: 0651-0051.

IC Instruments: PTO-1663, PTO-1683, PTO-2131, PTO-2132, PTO-2133, TEAS Global Forms.

Type of Review: Extension of an existing information collection.

Affected Public: Individuals or households; businesses or other for-profits; and not-for-profit institutions.

Estimated Number of Respondents: 14,691 responses per year. Of this total, the USPTO expects that 14,682 response will be submitted electronically via the TEAS system and 9 will be submitted on paper.

Estimated Time per Response: The USPTO estimates that it will take the public approximately between 20 minutes (0.33 hours) to seventy-five minutes (1.25 hours) to complete the information in this collection, including the time to gather the necessary information, prepare the forms or documents, and submit the completed request to the USPTO.

Estimated Total Annual Respondent Burden Hours: 4,878.97 hours.

Estimated Total Annual Respondent (Hourly) Cost Burden: \$2,136,988.86. The USPTO expects that an attorney will complete the instruments associated with this information collection. The professional hourly rate for an intellectual property attorney in private firms is \$438. Using this hourly rate, the USPTO estimates that the total respondent cost burden for this collection is \$2,136,988.86 per year.

#	Item	Estimated Time for Responses (a)	Estimated Annual Responses (b)	Estimated Annual Burden Hours (c) (a) x (b)	Rate (d)	Estimated Annual Respondent Cost (e) (c) x (d)
1	Application for International Registration (TEAS)	0.33 (20 minutes)	8,540	2,818.20	\$438.00	\$1,234,371.60
1	Application for International Registration (paper)	0.58 (35 minutes)	1	0.58	\$438.00	\$254.04
2	Application for Subsequent Designation (TEAS)	0.33 (20 minutes)	930	306.90	\$438.00	\$134,422.20
2	Application for Subsequent Designation (paper)	0.58 (35 minutes)	1	0.58	\$438.00	\$254.04
3	Response to Notice of Irregularity (TEAS)	0.33 (20 minutes)	315	103.95	\$438.00	\$45,530.10
3	Response to Notice of Irregularity (paper)	0.55 (33 minutes)	1	0.55	\$438.00	\$240.90
4	Replacement Request (TEAS Global)	0.50 (30 minutes)	1	0.50	\$438.00	\$219.00
4	Replacement Request (paper)	0.75 (45 minutes)	1	0.75	\$438.00	\$328.50
5	Request to Record an Assignment or Restriction of a Holder's Right to Dispose of an International Registration (TEAS Global)	0.33 (20 minutes)	3	0.99	\$438.00	\$433.62
5	Request to Record an Assignment or Restriction of a Holder's Right to Dispose of an International	0.50 (30 minutes)	1	0.50	\$438.00	\$219.00

	Registration (paper)					
6	Transformation Request (TEAS RF Global)	0.33 (20 minutes)	1	0.33	\$438.00	\$144.54
6	Transformation Request (paper)	0.55 (33 minutes)	1	0.55	\$438.00	\$240.90
7	Petition to Director to Review Denial of Certification of International Application (TEAS Global)	1 (60 minutes)	42	42.00	\$438.00	\$18,396.00
7	Petition to Director to Review Denial of Certification of International Application (paper)	1.25 (75 minutes)	1	1.25	\$438.00	\$547.50
8	Declaration of Continued Use/Excused Nonuse of Mark in Commerce Under Section 71 (TEAS)	0.33 (20 minutes)	3,250	1,072.50	\$438.00	\$469,755.00
8	Declaration of Continued Use/Excused Nonuse of Mark in Commerce Under Section 71 (paper)	0.42 (25 minutes)	1	0.42	\$438.00	\$183.96
9	Combined Declaration of Continued Use/Excusable Nonuse and Incontestability Under Sections 71 and 15 (TEAS)	0.33 (20 minutes)	1,600	528.00	\$438.00	\$231,264.00
9	Combined Declaration of Continued Use/Excusable Nonuse and Incontestability Under Sections 71 and 15 (paper)	0.42 (25 minutes)	1	0.42	\$438.00	\$183.96
	Totals		14,691	4,878.97		\$2,136,988.86

Estimated Total Annual (Non-hour) Respondent Cost Burden: \$12,182,254.50. The collection has annual (non-hour) costs in the forms of postage costs and filing fees.

Postage Costs

Customers may incur postage costs when submitting some of the items covered by this collection to the USPTO by mail. The USPTO expects that approximately 98% of the responses in this collection will be submitted electronically. Of the remaining 1 percent, the vast majority will be submitted by mail, for a total of 9 mailed submissions. The average first-class USPS postage cost for a mailed submission will be \$0.50. Therefore, the USPTO estimates that the postage costs for the mailed submissions in this collection will total \$4.50.

Filing Fees

The USPTO charges fees for processing international applications and related requests under the Madrid Protocol, as set forth in 37 CFR 2.6 and 37 CFR 7.6. Most of these fees are charged per class of goods or services. Therefore, the total fees can vary depending on the number of classes. Based on the minimum fee of one class per relevant document, the USPTO estimates that the total filing fees associated with this collection will be approximately \$12,182,250 per year, as calculated in the table below.

#	Item	Estimated Annual Responses (a)	Fee Amount (b)	Estimated Annual Filing Costs (c) (a) x (b)
1	Application for International Registration (for certifying an international application based on a single basic application or registration, per international class) (TEAS)	7,313	\$100.00	\$731,300.00
1	Application for International Registration (for certifying an international application based on a single basic application or registration, per international class) (paper)	1	\$200.00	\$200.00
1	Application for International Registration (for certifying an international application based on more than one basic application or registration, per international class) (TEAS)	1,227	\$150.00	\$184,050.00
1	Application for International Registration (for certifying an international application based on more than one basic application or registration, per international class) (paper)	1	\$250.00	\$250.00
1	Request for Extension of Protection of International Registration to the United States - Filed at WIPO	25,600	\$400.00	\$10,240,000.00
2	Transmitting a Subsequent Designation under Section 7.21 (TEAS)	930	\$100.00	\$93,000.00
2	Transmitting a Subsequent Designation under Section 7.21 (paper)	1	\$200.00	\$200.00
4	Notice of Replacement under Section 7.28 (per international class) (TEAS)	1	\$100.00	\$100.00
4	Notice of Replacement under Section 7.28 (per international class) (paper)	1	\$200.00	\$200.00
5	Request to Record an Assignment or Restriction, or Release of a Restriction, under Sections 7.23 and 7.24 (TEAS) (paper)	3	\$100.00	\$300.00
5	Request to Record an Assignment or Restriction, or Release of a Restriction, under Sections 7.23 and 7.24 (paper)	1	\$200.00	\$200.00
6	Transformation Request (per international class) (TEAS RF Global)	1	\$275.00	\$275.00
	Transformation Request (per	1	\$600.00	\$600.00

6	international class) (paper)			
7	Petition to Director to Review Denial of Certification of International Application (TEAS)	42	\$100.00	\$4,200.00
7	Petition to Director to Review Denial of Certification of International Application (paper)	1	\$200.00	\$200.00
8	Declaration of Continued Use/Excusable Nonuse of Mark in Commerce Under Section 71 (per international class) (TEAS)	3,250	\$125.00	\$406,250.00
8	Declaration of Continued Use/Excusable Nonuse of Mark in Commerce Under Section 71 (per international class) (paper)	1	\$225.00	\$100.00
8	Surcharge for Filing Affidavit Under Section 71 of the Act During the Grace Period, per international class (TEAS)	1	\$100.00	\$100.00
8	Surcharge for Filing Affidavit Under Section 71 of the Act During the Grace Period, per international class (paper)	1	\$200.00	\$200.00
9	Combined Declaration of Continued Use/Excusable Nonuse and Incontestability Under Sections 71 and 15 (per international class) (TEAS)	1,600	\$325.00	\$520,000.00
9	Combined Declaration of Continued Use/Excusable Nonuse and Incontestability Under Sections 71 and 15 (per international class) (paper)	1	\$525.00	\$525.00
	Totals	39,978		\$12,182,250.00

Therefore, the USPTO estimates that the total annual (non-hour) cost burden for this collection, in the form of postage costs (\$4.50) and filing fees (\$12,182,250), is \$12,182,254.50 per year.

IV. Request for Comments

Comments submitted in response to this notice will be summarized or included in the request for OMB approval of this information collection; they also will become a matter of public record.

Comments are invited on:

- a) Whether the proposed collection of information is necessary for the proper performance of the functions of the agency, including whether the information shall have practical utility;
- b) The accuracy of the agency's estimate of the burden (including hours and cost) of the proposed collection of information;

- c) Ways to enhance the quality, utility, and clarity of the information to be collected; and
- d) Ways to minimize the burden of the collection of information on respondents, e.g., the use of automated collection techniques or other forms of information technology.

Marcie Lovett,

Records and Information Governance Division Director, OCTO,

United States Patent and Trademark Office.

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